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United States Patent and Trademark Office
Trademark Trial and Appeal Board
P O Box 1451
Alexandria, VA 23313-1451

Rec'd

06/01/2005



920 43900

U.S. Reg. No. 1,384,270

The Die-Gem Co., Inc.
One The Die-Gem Way
Akron, Ohio 44312-1539

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Petition To Cancel No. 92043900

Omnova Solutions Inc.
175 Ghent Road
Fairlawn Ohio 44333-3300

V.

The Die-Gem Co., Inc

Answer to Cancellation No. 92043900

The respondent, The Die-Gem Co., Inc, denies the claims of abandonment, of the motion of petitioner Omnova Solutions Inc. for cancellation, of the mark PEEL N STICK.

Further:

Claim 1. The respondent, The Die-Gem Co., Inc, affirms the claim that

Registration No. 1,384,270 for the mark PEEL N STICK

International Class 17 was registered February 25, 1986 under the Trademark Act of 1946 and to remain in force for twenty years.

Claim 2. The respondent, The Die-Gem Co., Inc, affirms the claim that

Registration No. 1,384,270 for the mark PEEL N STICK International Class 17 filed a declaration under sections 8 and 15 for mark PEEL N STICK and was accepted by the United States Dept of Commerce Patent and Trademark Office April 27, 1992. The Trademark Registration No.1, 384,270 became incontestable.

Claim 3. The respondent, The Die-Gem Co., Inc, denies the claim that

Registration No. 1,384,270 for the mark PEEL N STICK

International Class 17 has been "abandoned" and "has made no

use” of the mark PEEL N STICK in the last three years and as part of the denial, that the petitioner, Omnova Solutions Inc., has shown bad faith by their allegations that The Die-Gem Co. has “made no use” of the mark PEEL N STICK. In a letter dated July 23, 2004 the petitioner, Omnova Solutions Inc., representative, in response to The Die-Gem Co. letter of July 5, 2004 to cease and desist in the use of the trademark, challenged respondent, The Die-Gem Co., by so stating, “Therefore Omnova Solutions will continue its two and one half years of conspicuous and continuous use of the PEEL & STICK mark on its unrelated commercial roofing products.” In this mocking, bragging manner the petitioner, Omnova Solutions Inc., clearly planned to continue the use of the mark PEEL & STICK™ in similar markets and thus continuing to dilute the respondent, The Die-Gem Co., valuable asset. Omnova Solutions Inc. application for the PEEL & STICK™ has twice been denied because of the similar market relationship between the two product lines.

At the stockholder meeting February 22, 2005 the Chairman, Chief Executive Officer and President Mr. Kevin M McMullen stated that Omnova Solutions “ had great plans for the further expanded use of their trademark PEEL & STICK™” by their subsidiary GenFlex Corp. He wrote PEEL & STICK™” on the blackboard and underlined it. Omnova Solutions Inc. has ulterior motives in petitioning for the cancellation of the mark PEEL N STICK and stating that there is no evidence of the use of PEEL N STICK® trademark.

Further the letter of July 5, 2004 to Omnova Solutions Inc. was a knowledge based letter to inform the highest ranking official that The Die-Gem Co., owned the PEEL N STICK® trademark and had been using the mark since 1973. This letter left no doubt of the intension of The Die-Gem Co., with regards to the mark PEEL N SICK.

Claim 4. The respondent, The Die-Gem Co., Inc, denies the claim that the petitioner Omnova Solutions Inc. did not receive documentation of the

use of the mark PEEL N STICK. A letter dated July 5, 2004 was sent to Mr. Kevin M McMullen Chairman, Chief Executive Officer, and President of Omnova Solutions Inc. and this letter was so noted by Omnova Solutions Inc. representative in their response of July 23, 2004. The proof of use of the mark PEEL N STICK owned by the respondent, The Die-Gem Co., was well within the reach of the petitioner, Omnova Solutions Inc., as is evident in **Proof-of-use.**

Claim 5. The respondent, The Die-Gem Co., Inc, again denies the claim that "a failure to use the mark PEEL N STICK and lack of intent to resume such use" and thus, that the mark is abandoned. This claim is totally without merit and the petitioner, Omnova Solutions Inc., has again shown bad faith in its petition for Cancellation when in a letter dated July 24, 2004 the representative of Omnova Solutions Inc. requested that The Die-Gem Co. further contribute to the dilution of the value of the valuable asset by agreeing to a "Consent Agreement", or "Omnova Solutions Inc. might be willing to purchase Die-Gem's alleged mark and registration for a modest sum, and then

license it back to Die-Gem". Why would we rent something we already own? The proof of use of the mark PEEL N STICK owned by the respondent, The Die-Gem Co., was well within the reach of the petitioner, Omnova Solutions Inc., as presented in **Proof-of-use.**

As part of the detailed answer to the petition to cancel the respondent, The Die-Gem Co., will reveal why the mark PEEL N STICK is coveted by Omnova Solutions Inc, that the mark PEEL N STICK has been used in commerce and PEEL N STICK® weatherstripping has been sold in commerce every year since 1972 and that mark PEEL N STICK will be used well into the future in commerce.

Trademark PEEL N STICK®

The trademark **PEEL N STICK®** identifies and distinguishes the source of the goods of respondent, The Die-Gem Company, from those of others. The Die-Gem Company doing business as KEL-EEZ® weatherstripping has established rights to this mark based on legitimate use in commerce.

Further The United States Patent and Trademark Office (USPTO) reviewed the PEEL N STICK mark application for federal registration. The mark had been used in commerce for 13 years, prior to the USPTO determining that the mark PEEL N STICK met the requirements for federal registration.

The mark PEEL N STICK was entitled to be registered under the Trademark Act of 1946 and to remain in force for twenty years.

A declaration under sections 8 and 15 for mark PEEL N STICK was filed and accepted by USPTO. The Trademark Registration No.1, 384,270 became incontestable within the meaning of the Trademark Act on April 27, 1992.

The respondent, The Die-Gem Company, d.b.a. KEL-EEZ® has had the mark PEEL N STICK registered on the Principal Register in order to give notice to the public in general and to companies such as in this proceeding Omnova Solutions Inc. of The Die-Gem Company claim of ownership of the mark PEEL N STICK. The value of the mark PEEL N STICK is the market appeal:

1. The mark PEEL N STICK gives a clear and concise description of how to install The Die-Gem Company products.

2. The simplicity of the mark states the meaning that (slang term) peel and stick is simple, easy and fast as a technique for the fastening system versus the subtle implication that nails, screws, clips, joints, welds etc., are time consuming.
- 3 The registration of the mark implies ownership and adds quality, durability and prestige to The Die-Gem products.
- 4.The mark (PEEL N STICK®) is a key to search the literature and the Internet without confusion to find the products of The Die-Gem Company.
5. The mark PEEL N STICK was first used in commerce in the sale of weather stripping to Sears Oak Brook (Ill) in February, 1973, Invoice # K3871 and # K3884.

The Intertwining of the mark PEEL N STICK has become the cohesive force for Growth in The Die-Gem Co., Inc.

Die-Gem was formed in 1969 as a consulting firm for adhesives, plastic and rubber processing and one of the customers was KEL-EEZ Products a manufacturer of weatherstripping.

KEL-EEZ Products had a major problem with their fastening system for weatherstripping. The Die-Gem Company was incorporated under the laws of the state of Ohio in 1971. The Die-Gem Co., Inc. d.b.a. KEL-EEZ® began manufacturing operations from the basement of the house at 1131 East Ave. Akron, Ohio producing weatherstripping installed by a pressure sensitive adhesive (PSA) fastening system. The Die-Gem Company has grown from working out of two basements and two garages to the Die-Gem Way an eight-acre site.

The PEEL N STICK® technology is the ingredient that has made The Die-Gem Company unique. It has allowed growth from two products to over 400. Without PEEL N STICK® brush weatherstripping would not have been invented. Over a billion dollars of brush weatherstripping is sold each year. PEEL N STICK® products are sold in the merchandising market, molding and trim market, air-conditioning and heating markets, automotive after market, electrical market, medical equipment market, and office furniture market as well as the general construction market. PEEL N STICK® products are used to seal radiant heating units that protrude through the roof. PEEL N STICK® products are bought and resold and used in many unknown markets

PEEL N STICK® Proof-of-use in commerce

The Die-Gem Co. will prove the use in commerce of the mark PEEL N STICK by demonstrating the broad extensive use in the markets served. The research and development that has been under way since 1995 demonstrates the intent to use and its planned continued use of the mark PEEL N STICK well into the future.

Proof-of-use

- A. A chronological list of control numbers called Adv# Exhibit #
- B. Listing of some types of Advertising & Media Exhibit # 1, 2 & 3
- C. Internet searches using Google search engine Exhibit # 4
- D. PEEL N STICK® Products a Description and Specification Exhibit # 5
- E. Research and development program under way since 1995 Exhibit # 6
- F. Plan of Action Exhibit # 7

Proof-of-use:

A. Chronological list of Control Numbers See

Exhibit # 8 for Adv# List

The Die-Gem Co has a recorded chronological list of control numbers called Adv# since 1972 that have been assigned to documents. This 38-page list (Exhibit 8) gives a history of the advertising, marketing strategy and other information through February 2005. It has been marked

CONFIDENTIAL. Product literature, catalogs etc are given an Adv#.

Initially dates were not always listed. As time passes use of PEEL N STICK becomes more prominent. Also as time progresses, the list includes date, description, and the person assigning the number to the document or form. In the current past, we have been adding the month, day, and year, which indicate first use of the form. This date is also printed on the form.

On the first page of the Adv# List one can glean that PEEL N STICK® (Adv# 11a) was first used in 1972 and that letters to were sent to architects, engineers, dealers and contractors (Adv# 6 & 12. The sale of PEEL N STICK® products was initially done through agents. News releases and catalog sheets are listed (Adv# 17 & 32). The first package for PEEL N STICK®, labels was for craft boxes (adv# 29). Products were sold in bulk prior to this with literature only. A list of outlets are listed at

(Adv# 20) Ill., Iowa, Ind., Wis., & Ohio. A Canadian Price schedule for Jobbers, department stores and distributors dated February 9, 1974 is listed at Adv# 42. Line drawings of PEEL N STICK® and displays are listed at Adv# 70 and 77. Some advertising control numbers assigned to documents in the 70s are still in use. These documents are up dated from time to time.

PEEL N STICK® brochures, mobile signs, color coded product packaging, catalog pages, and consumer literature, as well as advertising in newspapers, TV guide, Sweets, and Thomas Register Adv #s are listed. The marketing of PEEL N STICK® weatherstripping products has had to be flexible and mobile or it would not have been sold in every year from 1972 through 2005. Today's marketing strategy for PEEL N STICK weatherstripping could not have been imagined in the 1970s.

Exhibit # 8 gives the history of the mark PEEL N STICK from the 1970s through 2005. The larger the Adv # number the newer the work. The Die-Gem Co. has bound purchase order books from 1972 to substantiate purchase and support the claims of use.

Proof-of-use:

B. Listing of Some types of Advertising See Exhibit #**1, 2 & 3 for evidence**

KEL-EEZ® has been producing ad slicks and line drawings for distributor catalogs since 1972. KEL-EEZ contractor and consumer market advertising has been in the "How to and problem solving" vein with emphasis on the ease of installation with PEEL N STICK® fastening system for our weatherstripping products.

KEL-EEZ® applied for a copyright of a published work in Canada in 1983. The registered copyright was received March 22, 1983, Serial # 323116.

The Die-Gem Co. has been diligent with respect to the mark PEEL N STICK. All of KEL-EEZ product names and trademarks have been maintained with product directories. Some of these product directories are,

Sweets

Thomas Register et al.

Blue Book of Building & Construction

Arcat

Professional Builder/Professional Remodeler, Buyers
Guide

Brands and Their Companies

Hardware Age Home Improvement Buyers Guide

Hanley Wood Buyers Guide Builder Remodeler

Craftsmans Book National Construction Estimator

Ohio Manufacturing Guide

ACB Checking Bureau

Radio Advertising Bureau

Yellow Pages Publishers Association (YPPA)

Most of the product directories require a yearly update. Some directories list our product names and trademarks in multiple categories. KEL-EEZ products names and trademarks have been registered with Sweets and Thomas Register since the 1970s and most of the others since the 1980s. To further control the use of The Die-Gem Co. product names and trademarks in each year's book, a two-page guideline is returned with each form. As in the past, and is still the practice, if there is an error or misuse of a mark or name a hand written note on the return form will state that if they can not make the correction as stated in KEL-EEZ

attached Advertising Requirement form (Adv# 201), remove KEL-EEZ® trademarks and trade names from the directory.

Exhibit # 1 demonstrates, through media ads, ad slicks, advertising rules, in-store merchandising and product directory forms, use from the past to the present.

Exhibit # 2 demonstrates, in brochures, stuffers, catalogs and contractor as well as consumer product literature, use from the past to the present.

Exhibit # 3 demonstrates, use of packaging, package labels, package over-lay cards and carton stickers, use from the past to the present

Proof-of-use:

C. Internet Searches using Google Search Engine

Exhibit # 4

A Google search of the Internet has been carried out to show the mark PEEL N STICK® with relevant nouns and the words PEEL & STICK. Eleven terms were searched. The placement of the terms, total number search results and key words for each search are listed below. The detail of the Google search engine results are shown in Exhibit 4 4-1 through 4-11

KEL-EEZ or The Die-Gem Company has not now or ever had a business relationship with Google search engine. KEL-EEZ® weatherization products have been on the World Wide Web since 1999. KEL-EEZ weatherization includes PEEL N STICK products. The Die-Gem Company web site is at www.die-gem.com.

1. Search words: PEEL N STICK® WEATHERSTRIP

FOUND: 542 reference sites

KEL-EEZ position on list: 1 See Exhibit 4 4-1

2. Search words: PEEL N STICK® WEATHER STRIP

FOUND: 35,800 reference sites

KEL-EEZ position on list: 6 See Exhibit 4 4-2

3. Search words: PEEL N STICK® Brass weatherstrip

FOUND: 360 reference sites

KEL-EEZ position on list: 1 See Exhibit 4 4-3

4. Search words: PEEL N STICK® Brush weatherstrip

FOUND: 431 reference sites

KEL-EEZ position on list: 1 See Exhibit 4 4-4

5. Search words: PEEL N STICK® Door weatherstrip

FOUND: 703 reference sites

KEL-EEZ position on list: 5 See Exhibit 4 4-5

6. Search words: PEEL N STICK® window weatherstrip

FOUND: 611 reference sites

KEL-EEZ position on list: 2 See Exhibit 4 4-6

7. Search words: PEEL & STICK Door weatherstrip

FOUND: 504 reference sites

KEL-EEZ position on list: 50 See Exhibit 4 4-7

8. Search words: PEEL & STICK window weatherstrip

FOUND: 526 reference sites

KEL-EEZ position on list: 58 See Exhibit 4 4-8

9. Search words: PEEL & STICK

FOUND: 546,000 reference sites

KEL-EEZ position on list: Not found in the first 560 See Exhibit 4

4-9

10 Search words: PEEL & STICK™

FOUND: 569,000 reference sites

Omnova Solutions Inc. position on list: 12, 21 and others See

Exhibit 4 4-10 & 11

Search words PEEL N STICK®, PEEL & STICK and PEEL & STICK™ are well entrenched on the Internet. PEEL N STICK mark is totally entwined with all of KEL- EEZ Weatherization products and is the key word to product sales on the Internet. The search words PEEL & STICK and PEEL & STICK™ give over 500,000 search result sites. Exhibit 4- 10 and 11 show multiple results for PEEL & STICK™. This is further evidence of the bad faith shown by Omnova Solutions Inc. in continuing to dilute the mark PEEL N STICK.

An analysis of the site www.die-gem.com/ over a 90-day period indicates that there were over 57 thousand hits with 50 identifiable domains.

There were over 12 thousand domain hits from the United States. The domain types were .com, net and mil. There were over 2.5 million bites a day transferred. Exhibit 4 4-12 is the Thomas.net ad (a company profile) and is at

<http://www.ThomasNet.com/heading.html?cov=NA&which=prod&what=weather+stripping&heading=93110401&searchpos=18&cid=1089477&navsec=results> on the Internet.

Proof of use D, E & F are CONFIDENTIAL and are listed separately. The Exhibits 5, 6, and 7 are CONFIDENTIAL See titles below.

Proof-of-use:

D. PEEL N STICK® Products a Description and Specification

Exhibit # 5

Proof-of-use:

E. Research and Development Program under way since 1995

Exhibit # 6

Proof-of-use:

F. 1999 Plan of Action

Exhibit # 7

PAGES 20-24

DESIGNATED

CONFIDENTIAL

② 7/29/05

Motion to Dismiss the Cancellation Proceeding

The respondent, The Die-Gem Co., requests the Trademark Trial and Appeal Board dismiss the proceedings for cancellation of the mark PEEL N STICK® brought by the petitioner Omnova Solutions Inc. with prejudice.

The petitioner, Omnova Solutions Inc., has chosen to ignore The Die-Gem Company letter of July 5, 2004 expressly written to the Chairman, Chief Executive Officer and President Mr. Kevin M McMullen to inform him that respondent, The Die-Gem Company, is the owner of trademark Ser. No. 1384270 for the mark PEEL N STICK and that it was placed on the Federal Register February 25, 1986 and is in use nationally and internationally. Further, the petitioner, Omnova Solutions Inc., was informed that The Die-Gem Company mark PEEL N STICK, has been in use since February 3, 1973.

Further the letter to Omnova Solutions Inc. was a knowledge based letter to inform the highest ranking official that respondent, The Die-Gem Co., had the right to demand that they cease and desist from the use of the mark PEEL N STICK immediately. This letter left the door open for the principal official of the Omnova Solutions Inc. to respond. No principal of the Omnova Solutions Inc. chose to respond.

Omnova Solutions Inc representative has ridiculed and brought shame on respondent, The Die-Gem Co., by stating that “ apparently modest advertising, use, and promotion of Die-Gem’s alleged PEEL N STICK mark”. The petitioner, Omnova Solutions Inc., is continuing to show a complete lack of regard for the rules and regulations of The United

States Patent and Trademark Office. The petitioner, Omnova Solutions Inc., has shown repeated bad faith and is continuing to do so. The petitioner, Omnova Solutions Inc., is diluting the mark PEEL N STICK®. The petitioner, Omnova Solutions Inc., further believes that because of its relative size (8 Billion dollar company) compared to The Die-Gem Company that there will be no consequences to their continued use of the mark PEEL & STICK™ in the same areas of distribution and product advertisement as by The Die-Gem Company use of the mark PEEL N STICK® for the distribution of its products and advertisement to those markets.

Further saturation of the mark PEEL N STICK® by the continual use of the PEEL & STICK™ trademark is shown at their website www.omnova.com, in their 2004 Annual Report and 10K, and by their Chairman, Chief Executive Officer and President stressing the importance of brand identification, PEEL & STICK™ trademark at the annual stockholder meeting February 22, 2005. The petitioner, Omnova Solutions Inc., clearly is continuing to use the mark PEEL & STICK™ in similar markets and thus continuing to dilute the respondent, The Die-Gem Co., valuable asset.



James R Adams

President

The Die-Gem Co., Inc